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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,780	10/26/2000	Bruce L. Davis	60320	5578
23735	7590	02/22/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			JEAN, FRANTZ B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/697,780

Applicant(s)

DAVIS ET AL.

Examiner

Frantz B. Jean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/07/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's election of claims 1-18 filed on 10/22/04 due to the election/restriction requirements. Claims 19-31 were not selected.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 03/07/03 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Regarding election/restriction, Applicants have elected to pursue claims 1-18 of group 1 with traverse.

It must be noted once again to applicants that Claims 1-18 which are drawn to usage and charge determination are distinct and have separate utility to the rest of the claims. For example, claims 19-23 of group II are drawn to electronic credential; claims 24-29 of group III are drawn to selling Internet access card; and claims 30-31 of group IV are drawn to a card restricting access to or limiting browsing to particular web sites. These claims have different classification, therefore, they can't be analyzed with claims 1-18 of group I. Accordingly, the restriction is sustained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Jansen et al. US patent number 6,243,450 (Applicants' IDS).

As per claims 1 and 5, Jansen teaches a method of accessing a web page from a publicly accessible internet device (see fig 1, col. 1 lines 19-24), comprising: presenting an object to said device (a credit card is inserted by user in the device, col. 10 line 8); sensing said object with an optical sensor (card reader, 30 fig 4); decoding data produced by said optical sensor to yield an object identifier (the card reader presents a code to the microprocessor indicating that a credit card has been inserted in order to identify/select a payment method, col. 10 lines 8-15); consulting a first data structure associated to determine whether a web page corresponding to said object identifier is among those sponsored by a third party, so that user access to such web page is permitted without charge (col. 10 lines 1-6); if so, linking to said web page, said linking including consulting a second data structure to identify a web address corresponding to said object identifier, and directing a web browser to said address(vendor/sponsor service is free of charge see col. 1 lines 54-58); and if not, soliciting payment information from a user before linking to said web page and funding certain costs associated with providing the no-charge user linking to sponsored web pages by periodically charging said third party therefor (if other site beyond the vendor is visited a fee is charged to user before or after usage, see col. 10 lines 1 et seq).

As per claims 2-3, Jansen teaches the method of claim 1 in which said first data structure is associated with a proxy server (see fig 2), which is co-located with the device.

As per claim 4, Jansen teaches the method of claim 1 in which said first data structure is stored at a location remote from the device (26, fig 2).

As per claim 6, Jansen teaches if free access to the computer address is determined not to be permitted, informing a user that free access is not available and permitting the user to link to said computer address on a payment basis (see col. 4 lines 3-19).

As per claim 7, Jansen teaches the method of claim 5, which includes accessing a database record in accordance with said identifier, and obtaining from said database record a computer address corresponding thereto (col. 4 lines 50 et seq).

As per claim 8, Jansen teaches the method of claim 5 in which said identifier (col. 5 line 67; col. 9 lines 50 et seq) comprises said computer address.

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As per claims 9 and 10, Jansen coding/decoding implicitly comprises decoding a barcode and a digital watermark (see col. 10 lines 1-22).

As per claims 11-12, Jansen implicitly teaches a computer address that is a URL associated with a root domain, and if free linking to said address is permitted, then also permitting free linking to other URLs associated with said root domain; and a computer address that is a URL associated with a root domain, and said determining includes comparing said root domain with a list of domains to which access is to be freely permitted (see col. 4 lines 29-49).

As per claims 13-14, Jansen implicitly teaches a method of claim 5 in which said determining includes checking a list comprising address data to which free linking is permitted (see col. 1 lines 54-60; col. 4 lines 3-20; col. 1-7); and in which said list is stored in a data structure located remotely from said device (see also col. 9 lines 20-40).

As per claim 15, Jansen teaches a method of claim 14, which includes caching at least some data from said list at said device (see col. 4 lines 3-20; col. 5 lines 33 et seq; col. 9 lines 20-40).

As per claims 16-17, Jansen implicitly teaches a list that includes at least first and second domains, having first and second sponsors (vendors) respectively associated therewith, the method further including billing the first sponsor for free user access provided to the first domain, and billing the second sponsor for free user access provided to the second domain; and billing a sponsor a fee for access that is provided free to a user, wherein certain URLs associated with said sponsor are among computer addresses to which access is provided to users for free (see col. 4 lines 3-20; col. 5 lines 33 et seq and col. 9 lines 18-40).

As per claim 18, Jansen teaches a method of claim 17 that includes:
accessing a database record in accordance with said identifier;
obtaining from said database record a computer address
corresponding thereto; and providing at least some of said fee to an entity that maintains said database record (see col 9 lines 20 et seq and col. 5 lines 33 et seq).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean



FRANTZ B. JEAN
PRIMARY EXAMINER